

REMARKS

By this Amendment, Applicants amend claim 26 to address a minor informality. Claims 1-30 remain pending.

In the Office Action of March 12, 2004¹ (“OA”), claims 1-10 and 24-30 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; claims 1-25 and 28-30 were rejected under 35 U.S.C. § 102(a) as being anticipated by PCT International Publication No. WO 01/18674 A2 (“*Maloney*”); and claims 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Maloney* in view of U.S. Patent No. 6,293,284 to *Rigg* (“*Rigg*”). In addition, claim 26 was objected to for an informality. Applicants address the rejections and objection as set forth below.

Rejection of claims 1-10 and 24-30 under 35 U.S.C. § 101

Applicants traverse the rejection of claims 1-10 and 24-30 under 35 U.S.C. § 101 because these claims are statutory, as discussed below.

According to the Examiner, the recitations of claims 1-10 and 24-30 are “abstract ideas which can be performed ... without interaction of a physical structure” and are not “in the technological arts” (OA at 2). Applicants disagree. According to the Federal Circuit, the inquiry of whether a claim is statutory focuses on “the essential characteristics of the subject matter, in particular, its practical utility.” *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1375. If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. *See State Street*, 149 F.3d at 1373,

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1358. And if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101.

The allegations in the Office Action indicate that the Examiner may be relying on the “Examination Guidelines for Computer-Related Inventions” set forth in M.P.E.P § 2106 in rejecting the claims. M.P.E.P. § 2106(II)(A) states:

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101...Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection (internal citations omitted).

Applicant points out that the Examiner failed, in every respect, to establish a *prima facie* showing that claims 1-10 and 24-30 are “abstract ideas.” The Examiner’s conclusory statements that the claims do not “recite a limitation in the technological arts” and that the recitations “are abstract ideas which can be performed mentally without interaction of a physical structure” are wholly unsupported and do not by themselves establish that the claims are “devoid of any limitation to a practical application in the technological arts,” as set forth in M.P.E.P. § 2106(II)(A). Because the Examiner fails to provide any evidence to support the allegations in the Office Action, the rejection of claims 1-10 and 24-30 under 35 U.S.C. § 101 should be withdrawn, regardless of whether the Examiner is in fact relying M.P.E.P § 2106.

The Examiner’s failure to establish the required *prima facie* showing notwithstanding, claims 1-10 and 24-30 are statutory for at least following reasons. Claims 1-10 and 24-30 include recitations that produce “concrete, tangible and useful” results and, therefore, accomplish a practical application and are not abstract. Claim 1 recites, *inter alia*:

based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject; and

informing the subject about said at least one customized set of testing material.

These steps produce useful, concrete, and tangible results. For example, selecting a customized set of testing material is a useful, non-abstract result that facilitates a determination of quantitative information that would aid in at least one beauty product recommendation. Further, “selecting a customized set of testing material” involves “interaction of a physical structure.” In addition, informing a subject about a customized set of testing materials is a useful, non-abstract result.

The Examiner alleges that Applicants’ claims are not within the technological arts. Contrary to the Examiner’s allegations, Applicants submit that claim 1 does have tangible applications within the technological arts. Moreover, Applicants point out that whether or not a process can be performed “without physical and/or computer means” is not dispositive of determining whether a claimed process is statutory. In fact, the Federal Circuit indicated that arguing that process claims are not patentable subject matter because they lack physical limitations “reflects a misunderstanding of...[the] case law.” *AT&T*, F.3d at 1359.

Independent claims 24 and 25, although of different scope, are not abstract for at least reasons similar to those presented above in connection with claim 1. Further, claim 24 has a practical application in that “ascertaining ... desired quantitative information by collecting data derived from use of the testing material on the subject,” as recited in the claim, is a useful, non-abstract result that facilitates at least one beauty product recommendation. Claims 1-10 and 24-30 are drawn to useful, concrete, and tangible results, and are therefore not abstract but, rather, statutory under 35 U.S.C. § 101.

For at least the foregoing reasons, the rejection of claims 1-10 and 24-30 under 35 U.S.C. § 101 should be withdrawn, and Applicants request such withdrawal.

Objection to claim 26

In the Office Action, claim 26 was objected to for an informality. Specifically, the Examiner questioned whether claim 26 should depend from claim 25 instead of claim 28. Claim 26 has been amended to depend from base claim 25. Applicants therefore request that the Examiner withdraw the objection to claim 26.

Rejection of claims 1-25 and 28-30 under 35 U.S.C. § 102(a)

Applicants traverse the rejection of claims 1-25 and 28-30 under 35 U.S.C. § 102(a) based on *Maloney* because *Maloney* does not teach all of the features recited in claim 1. For example, *Maloney* does not teach at least “based on ... received answers [to personal questions on at least one topic including characteristics of at least one external body condition of a subject], selecting from a plurality of testing materials ... at least one customized set of testing material ...,” as claimed.

Maloney is directed to providing a customized product to a consumer (Abstract). Although *Maloney* describes obtaining personal information and providing a test kit to a consumer (p. 11, lines 7-9; 26-30), it does not disclose or suggest that the test kit is selected from a plurality of testing materials or based on obtained personal information. *Maloney* merely mentions providing a test kit that “might comprise one or more tests” in order to collect “profiling data” about a consumer (p. 11, lines 6-7). Providing a consumer with a standard test kit in order to collect data about the consumer, as described by *Maloney*, however, does not teach or suggest selecting a customized set of testing materials based on answers to personal questions, as recited in claim 1. Further, the mere fact that *Maloney* describes obtaining personal information does not teach or suggest using such information as a basis for selecting a

customized set of testing material, as recited in claim 1. In fact, *Maloney* describes (p. 11) that personal information is used to provide the user with a customized interface, not a customized set of testing material. For at least these reasons, *Maloney* does not teach or suggest the invention recited in claim 1. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 1.

The Examiner rejected claims 11, 20, 24, and 25 for reasons similar to those presented in the rejection of claim 1. Each of claims 11, 20, and 24 recites, *inter alia*, “based on ... received answers [to personal questions on at least one topic including characteristics of at least one external body condition of a subject], selecting from a plurality of testing materials ... at least one customized set of testing material” Claim 25 recites, *inter alia*, “based on ... received information [regarding at least one external body condition of a subject], selecting from a plurality of testing materials ... at least one customized set of testing material” For at least the reasons presented above in connection with claim 1, *Maloney* does not teach at least the above-noted features of claims 11, 20, 24, and 25.

Because *Maloney* fails to anticipate claims 1, 11, 20, 24, and 25, the rejection of these claims under 35 U.S.C. §102(a) should be withdrawn. The rejection of claims 2-10, 12-19, 21-23, and 28-30 should be withdrawn as well, at least because of the respective dependence of those claims from base claims 1, 11, 20, and 25. Accordingly, Applicants request withdrawal of the rejection of claims 1-25 and 28-30 under 35 U.S.C. §102(a) and the timely allowance of these pending claims.

Rejection of claims 26 and 27 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 26 and 27 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established based on *Maloney* and *Rigg*. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), each of three requirements must be

met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Claim 26 depends from claim 25 and therefore includes all of the features recited in claim 25. For at least the reasons presented above in connection with claim 25, *Maloney* does not anticipate or render obvious claim 26. Additionally, as the Examiner appears to acknowledge, *Maloney* fails to disclose that “the information is chosen from answers to questions and at least one representation of the external body condition,” as recited in claim 26 (see OA at 5).

Rigg fails to cure the deficiencies of *Maloney*. *Rigg* is directed to a virtual makeover (Abstract). *Rigg* does not teach or suggest, for example, “based on ... received information [regarding at least one external body condition of a subject], selecting from a plurality of testing materials ... at least one customized set of testing material ..., ” as claimed. *Maloney* and *Rigg* therefore fail, alone and in combination, to teach or suggest each and every element recited in claim 26. For at least this reason, a *prima facie* case of obviousness has not been established with respect to claim 26.

Further, *prima facie* obviousness has not been established at least because the requisite motivation to combine the references is lacking. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions

of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, there is no “substantial evidence” in the record to support the attempted combination of *Maloney* and *Rigg*, and the requisite “clear and particular” motivation to support a *prima facie* case of obviousness is lacking. The Examiner does not show, by substantial evidence, that a skilled artisan having the cited references before him, and not having the benefit of Applicants’ disclosure, would have been motivated to combine those references in the manner resulting in Applicants’ claimed combination. The Examiner merely provides a description of how *Rigg* allegedly teaches certain features not found in *Maloney* without a proper motive for combining *Rigg* with *Maloney*.

The Examiner alleged (OA at 5) that a skilled artisan would have combined *Maloney* and *Riggs* “because the digital scan would provide the most accurate determination of natural skin color, thereby resulting in consultant’s best recommendations.” These conclusory statements in the Office Action are not properly supported by facts on the record and do not evidence that a skilled artisan would have been motivated to combine the references in a manner resulting in Applicants’ claimed combination absent Applicants’ disclosure. The Examiner fails to provide any evidence, beyond conjecture, to show that a digital scan would provide “the most accurate determination of natural skin color” or that an accurate determination of skin color would result in a “consultant’s best recommendations.” Indeed, the Examiner fails to show that either of the relied-upon references suggests combining their teachings.

Applicants call attention to M.P.E.P. § 2143.01, which makes clear that

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (citations omitted).

The Examiner does not show that the cited art “suggests the desirability of the” combination. No objective reason for combining the applied art to achieve the invention defined by claim 26 has been established.

Applicants note that the requirements for establishing *prima facie* obviousness must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001). As M.P.E.P. § 2142 articulates:

Knowledge of applicant's disclosure must be put aside....
[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants’ claims were improperly used to reconstruct the prior art. A skilled artisan would not have been motivated, without consulting Applicants’ disclosure, to combine the teachings of *Maloney* and *Rigg*. *Maloney* mentions providing a customized product to a consumer, and *Rigg* describes a virtual makeover. Neither of these references, however, teaches or suggests combining their respective teachings as alleged in the Office Action. The conclusions in the Office Action, therefore, constitute improper hindsight reasoning.

Because the required motivation to combine the applied references is lacking, and since the applied references (even if combined) fail to teach or suggest each and every claimed feature, *prima facie* obviousness has not been established with respect to claim 26.

Claim 27 depends from claim 25 and therefore includes all of the features recited in claim 25. For at least the reasons presented above in connection with claim 25, *Maloney* does not

anticipate or render obvious claim 27. Additionally, as acknowledged by the Examiner, *Maloney* fails to disclose that “the information is an image of the external body condition,” as recited in claim 27 (OA at 5).

As explained above in connection with claim 26, *Rigg* fails to cure *Maloney*’s deficiencies. *Maloney* and *Rigg* therefore fail, alone and in combination, to teach or suggest each and every element recited in claim 27. Further, the requisite motivation to combine the references is lacking, as explained above in connection with claim 26. For at least these reasons, a *prima facie* case of obviousness has not been established with respect to claim 27.

Because *prima facie* obviousness has not been established with respect to claims 26 and 27, the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn. Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of these claims.

Conclusion


The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicants therefore request the Examiner’s reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 14, 2004

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